

Remarks

In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise. Applicant notes at the outset that the Examiner has produced no explanation for the rejection of claim 5. Moreover, the Examiner has improperly introduced new rejections (not necessitated by amendment) in a final office action. For example, the rejection to claim 1 under 35 U.S.C. § 112(2) is presented for the first time and is directed to the clarity of elements that were not introduced by amendment. In view of the impropriety of the finality of the office action, Applicant respectfully submits that the amendments should be entered and the finality withdrawn.

The final Office Action dated June 20, 2008, lists the following rejections: claims 1-6, 9-12 and 14 stand rejected under 35 U.S.C. § 112(2); and claims 1-6 and 10-12 stand rejected under 35 U.S.C. § 102(b) over Andresen *et al.* (U.S. Patent No. 6,211,693). The Office Action also notes an objection to the drawings.

Applicant respectfully submits that the finality of the office action is improper. The Examiner has improperly introduced new § 112(2) rejections in the final office action without first affording Applicant an opportunity to respond. M.P.E.P. 706.7(a) states that the finality of an office action is not proper where the Examiner introduces a new ground of rejection that is not necessitated by Applicant's amendment of the claims. For at least independent claims 1 and 7, the elements identified as unclear were present in the claims prior to Applicant's response of January 23, 2008, and thus, the new grounds for rejection were not necessitated by an amendment by Applicant. Moreover, to the extent that any evidence is presented in support of the rejection (*e.g.*, identifying "an activation circuit," "test line" and "a detection circuit"), the evidence has not been presented previously. Accordingly, Applicant has not been afforded a fair opportunity to respond to the rejection.

Moreover, claims 1 and 10 each contain the limitations that were present in the (now cancelled) dependent claims 7 and 13. There was no outstanding 35 U.S.C. § 102(b) rejection for these claims in the Office Action of April 12, 2007, and therefore, the Examiner's application of a new 35 U.S.C. § 102(b) rejection for these claims in a final office action is improper and does not afford Applicant a fair opportunity to respond

as the rejection could have been applied in the previous action. Accordingly, it is disingenuous for the Examiner to assert that the new 35 U.S.C. § 102(b) rejection of claims 1 and 10 was necessitated by amendment.

For the aforementioned reasons, Applicant submits that the finality of the Office Action should be withdrawn so as to avoid a possible petition under 37 C.F.R. § 1.181.

Applicant notes that claim 5 is indicated as rejected under 35 U.S.C. § 102(b) over Andresen; however, the Examiner has not presented any argument in support thereof. Accordingly, Applicant respectfully submits that there is not a *prima facie* case for a rejection for claim 5 and requests that the rejection be withdrawn or that an explanation be provided along with a withdrawal of the finality of the office action.

Applicant respectfully traverses the § 112(2) rejections of claims 1-6, 9-12 and 14 because the Examiner has not provided sufficient analysis thereof and because the claims are clear and in compliance with § 112(2).

Regarding the rejection of claim 1, the Examiner states that the rejection is for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; however, the Examiner identifies “an activation circuit,” “test line” and “a detection circuit for detecting the switching state of said switching circuit” as unclear. M.P.E.P. § 2171 states that an examiner should explain whether the rejection is based on indefiniteness (clarity) or on the failure to claim what applicants regard as their invention. Here the Examiner has identified both rationales, without providing clarification for the rationales. For the purposes of this rejection (including the § 112(2) rejections of claims 2-6, 9-12 and 14), Applicant has assumed that the rejection is based upon an assertion that the claim limitations are unclear.

M.P.E.P. 2173 states that an analysis as to why the phrase(s) used in the claim is “vague and indefinite” should be provided to sustain a § 112(2) rejection. Applicant respectfully submits that the Examiner has merely identified elements and then concluded that they are unclear. The Examiner has not indicated what about the terms is unclear and instead has presented a conclusory statement and a question about whether the elements are found in the drawings. Applicant notes that because the terms have clear meanings on their face, it is unclear why the Examiner is asking whether the items are shown in the drawings. It appears that the Examiner may be improperly applying a

§ 112(1) type argument. Should this be the case, Applicant requests clarification and an opportunity to respond before a final office action. Notwithstanding the deficiencies of the rejection, each claim term is clear and definite as detailed in the following discussion.

Regarding claim 1, as indicated in the claims, the activation circuit is used to activate the cascode element. Thus, the activation circuit is a circuit that activates a cascode element. The claims indicate that the test line connects a group of switching elements to provide functionality associated with the electric signal on the test line. The claims indicate that the detection circuit is for detecting a switching state of a switching circuit. Thus, each of the claim elements identified by the Examiner as unclear is explicitly defined by the claim language in structure (*e.g.*, line, elements or circuit) and/or function (*e.g.*, carrying an electrical signal, activating or detection). Applicant respectfully submits that this language is clear on its face, and thus, the rejection is improper. Accordingly, the rejections are improper and Applicant requests that they be withdrawn.

Regarding claim 8 and 14, Applicant notes that the un-amended claim 14 had explicit antecedent basis for the term “said test point” in claim 11, from which it depends. Applicant notes that the failure to provide explicit antecedent basis for terms does not necessarily render a claim indefinite (see M.P.E.P. § 2713.05(3)). Notwithstanding, Applicant has made amendments to the claims, thereby rendering the rejection moot.

Regarding claim 10, Applicant has made an amendment to facilitate prosecution by changing the term “means” to “a detection circuit.” The claim term is clear and definite as it expressly defines a structure (circuit) and a function (detection) associated with various limitations.

Regarding claim 11, Applicant has made an amendment to facilitate prosecution by changing the term “means” to “circuitry.” The claim term defines the structure (circuitry) and function (applying voltages and detecting current as specifically claimed) and the claim term in question is clear and definite.

Notwithstanding, and in an effort to facilitate prosecution, Applicant wishes to help the Examiner’s understanding of the invention. The following examples are merely representative of one or more embodiments of Applicant’s invention and do not necessarily limit the claimed invention thereto. An example of the functionality

associated with term “activation circuit” can be found in relation to element 15 of FIG. 6 and the related discussion beginning at paragraph 0013. An example of the functionality associated with the term “test line” can be found in relation to elements 31 and 32 of FIG. 9 and the related discussion beginning at paragraph 0048. An example of the functionality associated with the term “detection circuit” can be found in relation to element 78 and the related discussion beginning at paragraph 0049.

In view of the clarity of the claims terms and the further explanations provided in Applicant’s specification, Applicant respectfully submits that the rejection under § 112(2) is improper and should be withdrawn.

Applicant respectfully traverses the objection to the drawings. In support of Applicant’s position reference is made to 35 USC §113 and M.P.E.P. §601.01(f), which indicate that “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.” The Office Action has not indicated why one skilled in the art would not be able to understand the claimed invention. In addition, M.P.E.P. § 601.01(f) indicates that it has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC §113. Since the claims in the current application include method claims, Applicant has complied with M.P.E.P. §601.01(f). Accordingly, Applicant requests that the objection to the drawings be removed.

Applicant respectfully traverses rejection of the claims 1-6 and 10-12 under 35 U.S.C. § 102(b) over the Andresen reference for failing to show correspondence to each claim limitation. Claims 1 and 10 each include limitations directed to selectable voltages on two different test lines. As discussed in Applicant’s specification, the Andresen reference fails to provide the choice of voltages between two such test lines (*see, e.g.*, Applicant’s specification at paragraph 0054). Accordingly, Applicant respectfully submits that each of the rejections is improper and requests that they be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any

App. Serial No. 10/509,863
Docket No.: CH020005US

remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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